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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86048207
Applicant	PUP SCOUTS, LLC
Applied for Mark	PUP SCOUTS
Correspondence Address	MATTHEW H. SWYERS THE TRADEMARK COMPANY 344 MAPLE AVE W STE 151 VIENNA, VA 22180-5612 UNITED STATES mswyers@thetrademarkcompany.com
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Filer's Name	Matthew H. Swyers
Filer's e-mail	mswyers@thetrademarkcompany.com
Signature	/Matthew H. Swyers/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	
Pup Scouts, LLC	:	
	:	Examining Attorney: Jean H. Im
Serial No.: 86/048,207	:	
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Filed: August 26, 2013	:	Law Office: 101
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Mark: PUP SCOUTS	:	
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BRIEF OF THE APPLICANT

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I. INTRODUCTION

COMES NOW the Applicant Pup Scouts LLC (hereinafter “Applicant”), by counsel Matthew H. Swyers, Esq., The Trademark Company, PLLC, and submits the instant Brief of the Applicant in support of Applicant’s contention that the instant mark should be permitted to register.

II. STATEMENT OF THE CASE


On or about August 26, 2013 Pup Scouts LLC applied to register the trademark PUP SCOUTS in connection with a collective membership mark “indicating membership in an organization for pets and their human counterparts” The application was filed as an in-use application under Section 1(a) of the Act, with the first use date of May 1, 2010.

On December 23, 2013 the Office conducted its initial review of the application. At that time the Office refused registration of the Applicant’s trademark on the grounds that, if registered, applicant’s trademark would create a likelihood of confusion with four prior registrations, namely, U.S. Registration Nos. 3501260, 3501263, 3501265, and 3501266.


U.S. Registration No. 3501260 is for the service mark DOG SCOUTS OF AMERICA used on or in connection with the following services in International Class 35: “On-line retail store services featuring clothing, gift items, water bottles, dog packs and harnesses, books and products, equipment and accessories for the care and training of dogs; and, Association services, namely, promoting the interests of pets and pets parents through the promotion of responsible pet parenting and ownership and through educating people about the care and training of their dogs and the importance of the human/canine bond” The registrant of this service mark is listed as Dog Scouts of America.

U.S. Registration No. 3501263 is for the service mark DOG SCOUTS OF AMERICA used on or in connection with the following services in International Class 41: “Providing live and on-line educational services, namely, classes, seminars and camps in the fields of responsible pet parenting and ownership; dog training services, conducting seminars on dog training and dog care, conducting dog training; dog training camps; and providing on-line educational information in the field of dog care and training.” The registrant of this service mark is listed as Dog Scouts of America.



U.S. Registration No. 3501265 is for the service mark  used on or in connection with the following services in International Class 41: “Providing live and on-line educational services, namely, classes, seminars and camps in the fields of responsible pet parenting and ownership; dog training services, conducting seminars on dog training and dog care, conducting dog training; dog training camps; and providing on-line educational information in the field of dog care and training.” The registrant of this service mark is listed as Dog Scouts of America.



U.S. Registration No. 3501266 is for the service mark  used on or in connection with the following services in International Class 35: “On-line retail store services featuring clothing, gift items, water bottles, dog packs and harnesses, books and products, equipment and accessories for the care and training of dogs; and, Association services, namely, promoting the interests of pets and pets parents through the promotion of responsible pet parenting and ownership and through educating people about the care and training of their dogs

and the importance of the human/canine bond.” The registrant of this service mark is listed as Dog Scouts of America.

III. ARGUMENT IN SUPPORT OF REGISTRATION

The Examining Attorney refused registration of the mark on the basis that, if registered, the Applicant’s mark would create a likelihood of confusion with the prior registered

marks DOG SCOUTS OF AMERICA, DOG SCOUTS OF AMERICA,



, and



as used by Dog Scouts of America as more fully identified in U.S. Registration Numbers 3,501,260, 3,501,263, 3,501,265, and 3,501,266 (hereinafter referred to collectively as “Dog Scouts of America marks”).

Applicant respectfully disagrees with the Examining Attorney’s decision as more fully set forth below.

The Standard for a Determination of a Likelihood of Confusion

A determination of likelihood of confusion between marks is determined on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The examining attorney is to apply each of the applicable factors set out in *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant *du Pont* factors are:

- (1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression;

- (2) the similarity or dissimilarity and nature of the services as described in an application or registration or in connection with which a prior mark is in use;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing;
- (5) the number and nature of similar marks in use on similar services; and
- (6) the absence of actual confusion as between the marks and the length of time in which the marks have co-existed without actual confusion occurring.

See id.

The examining attorney is required to look to the overall impression created by the marks, rather than merely comparing individual features. *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1029, 10 USPQ2d 1961 (2d Cir. 1989). In this respect, the examining attorney must determine whether the total effect conveyed by the marks is confusingly similar, not simply whether the marks sound alike or look alike. *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1870 (10th Cir. 1996) (recognizing that while the dominant portion of a mark is given greater weight, each mark still must be considered as a whole)(citing *Universal Money Centers, Inc. v. American Tel. & Tel. Co.*, 22 F.3d 1527, 1531, 30 USPQ2d 1930 (10th Cir. 1994)). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. In *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627, 3 USPQ2d 1442 (8th Cir. 1987), the court held that “Oatmeal Raisin Crisp” and “Apple Raisin Crisp” are not confusingly similar as trademarks. Also, in *First Savings Bank F.S.B. v. First Bank System Inc.*, 101 F.3d at 645, 653, 40 USPQ2d 1865, 1874 (10th Cir. 1996), marks for “FirstBank” and for “First Bank Kansas” were found not to be confusingly similar. Further, in *Luigino’s Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark

“Lean Cuisine” was not confusingly similar to “Michelina’s Lean ‘N Tasty” even though both marks use the word “Lean” and are in the same class of services, namely, low-fat frozen food.

Concerning the respective goods or services with which the marks are used, the nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. *See, e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1690 n.4 (Fed. Cir. 1993); *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (C.C.P.A. 1973). *See generally* TMEP § 1207.01(a)(iii).



If the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are similar confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (*e.g.*, lamps, tubes) related to the photocopying field). *See generally* TMEP § 1207.01(a)(i).

Moreover the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are immune from source confusion. *See In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). However, circumstances suggesting care in purchasing may tend to minimize likelihood of confusion. *See generally* TMEP § 1207.01(d)(vii).

Applying the legal standards as enumerated above, it is clear that confusion is not likely to exist and Applicant's mark is entitled to register despite the existence of the cited mark.

A. Dissimilarities in the Marks as to their Respective Appearances

The Applicant applied to register the mark PUP SCOUTS. The cited marks are for DOG SCOUTS OF AMERICA (Reg. No. 3501260), DOG SCOUTS OF AMERICA (Reg. No.

3501263),  (Reg. No. 3501265), and  (Reg. No. 3501266). Copies of Applicant's mark and the blocking marks were attached as Exhibits 1 through 5 respectfully. *See* Exhibits 1 – 5 previously made of record in connection with Applicant's Office Action Response.

Facially, the applied for mark differs from the cited marks insofar as Applicant's mark consists of the standard character phrase "PUP SCOUTS." In contrast, the Registrant's marks contain the term DOG SCOUTS. It is submitted that consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be

impressed upon the mind of a purchaser and remembered” when making purchasing decisions). It is likely that consumers will focus on the term “PUP” in the blocking mark and relate the services of the Applicant’s mark to puppies, or young canines and will not confuse that with the first term of Applicant’s mark, DOG. Based on this theory, if the consumer then places his or her focus on the first word in a mark, different connotations do exist. Thus, it cannot be said that the marks are identical and true differences do exist in the appearances thereof. Applicant respectfully submits that this *du Pont* factor favors a finding of an absence of a likelihood of confusion should Applicant’s mark be permitted to register.

B. Dissimilarities Between the Trade Channels for the Marks

Applicant’s organization for pet owners offered in connection with the PUP SCOUTS mark is currently available through local events where troops are located, as well as through social media outlets. Additionally Applicant offers franchised use of the PUP SCOUTS name for retail sales. *See Exhibit 6, Affidavit of Kay Lorinc* previously made of record in connection with Applicant’s Office Action Response. In contrast, it appears that the services offered in connection to the Dog Scouts of America marks are offered exclusively to consumers located in Michigan and Texas. Merit badges and bandanas are not available on a retail website, but rather via purchase through the DOG SCOUTS organization. *See Exhibit B, Affidavit of Kay Lorinc* previously made of record in connection with Applicant’s Office Action Response.

As such, it is respectfully submitted that Applicant’s services travel in a channel of trade wholly diverse from those which would be expected for the services of the cited marks. Moreover, as the evidence of record indicates that the Applicant’s channel of trade for its services are completely distinct for the services of the cited marks, it is submitted that their respective services would not be encountered by the same persons in situations that would create

the incorrect assumption that such goods originate from the same source and, accordingly, this *du Pont* factor also favors registration of the Applicant's mark.

C. The Marks' Goods and Services are Marketed Differently

The services bearing the PUP SCOUTS mark are marketed primarily through the Pup Scouts handbook, cable television and radio commercials, Spanish language television channels, German language television channels, events such as "Tea Pawty with the pawrents," and "Mutts and Martinis," trade shows, Oscar Swag bags, websites blogs, social media, partnerships, brochures banner ads, newsletters, advertisements on restaurant menus, and on Craigslist. *See* Exhibit 6, Affidavit of Kay Lorinc previously made of record in connection with Applicant's Office Action Response.

In contrast, although the DOG SCOUTS OF AMERICA marks are marketed on a website, the target audience is for potential members in to potential members in Michigan and Texas, and they do not appear to advertise through a handbook, cable television and radio commercials, Spanish language television channels, German language television channels, events (Tea Pawty with the pawrents, Mutts and Martinis), trade shows, Oscar Swag bags, websites blogs, social media, partnerships, brochures banner ads, newsletters, advertisements on restaurant menus, or on Craigslist.

As such, it is respectfully submitted that this factor also favors registration of the Applicant's mark.

D. Sophistication of the Purchasers and Members of the Respective Goods

Applicant's membership services offered in connection with the PUP SCOUTS mark are designed to attract a very specific consumer, namely, those interested in honoring their pets by means of participating in collective group with other pet owners. In contrast, it can only be

assumed that the DOG SCOUTS OF AMERICA mark is used to attract those seeking education, certification and training for dogs and dog owners. *See* Exhibit 6, Affidavit of Kay Lorinc previously made of record in connection with Applicant's Office Action Response.

As such, the average purchaser or member of the respective services offered under the cited marks would also exercise careful thought in choosing the cited marks' services as apart from the services of the Applicant's mark, therefore minimizing any likelihood of confusion. *See* TMEP § 1207.01(d)(vii). As such, it is suggested that these *du Pont* factors also favors registration of the instant mark.

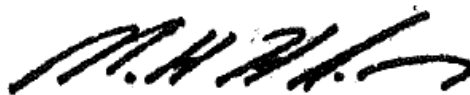
IV. CONCLUSION

In conclusion, based upon the foregoing it is submitted that the *du Pont* factors addressed herein favor registration of the Applicant's mark. The services themselves are completely distinct and do not travel in similar trade channels or marketing channels such that they would be encountered by the same class of purchasers or members.

WHEREFORE it is respectfully requested that the Board reverse the decision of the examining attorney and allow the instant mark to register.

Respectfully submitted this 3rd day of October, 2014.

THE TRADEMARK COMPANY, PLLC



Matthew H. Swyers, Esquire
344 Maple Avenue West, Suite 151
Vienna, VA 22180
Tel. (800) 906-8626 x100
Facsimile (270) 477-4574
mswyers@thetrademarkcompany.com